



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Epke Bosma

Conf.: 4500

Appl. No.: 10/511,582

Group: 3643

Filed: October 18, 2004

Examiner: Son T. Nguyen

For: AUTOMATIC MILK SEPARATION

Docket No.: 19200-000041/US

Customer Service Window

November 12, 2009

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Mail Stop Appeal Briefs - Patents

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

Madam:

In response to the Examiner's Answer mailed September 11, 2009, Applicants request the appeal be maintained and supply the following arguments in reply under 37 C.F.R. § 41.41(a) (1).

I. STATUS OF CLAIMS:

Applicants acknowledge the Examiner's status of the claims in her Answer is correct. Claims 1-3 and 5-13 are pending. Claim 4 has been cancelled, and claims 8-13 are withdrawn. Claims 1-3 and 5-7 currently stand rejected and are the subject of this appeal. Claim 1 is an independent claim.

The claims are rejected as follows:

11/13/2009 SZEWDIE1 00000004 10511582

01 FC:1403

1080.00 OP

1. Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite.
2. Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.
3. Claims 1-3, 5, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Pat 5,704,311 to Van den Berg ("Van den Berg") in view of Swedish Patent Publication 200000179 to Birk ("Birk").
4. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Van den Berg in view of Birk and US Pat pub 2004/0168643 to Nilsson ("Nilsson").

Claims 1-3 and 5-7 are being appealed.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

Appellant seeks the Board's review of the following rejections:

1. The rejection to claims 1-3 and 5-7 under 35 U.S.C. § 112, second paragraph as being indefinite.
2. The rejection to claims 1-3 and 5-7 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.
3. The rejection to claims 1-3 and 5-7 under 35 U.S.C. § 103(a) as being obvious.

III. REPLY ARGUMENT

A. The Examiner's implausible interpretation of the claim is insufficient to reject the claims for indefiniteness.

In response to the Applicants' argument that the limitation of claim 1, "said second indicator of mastitis not based on a milk quality measured by the first indicator," has a single plausible and definite interpretation, the Examiner answers that the phrase makes no sense, because the second indicator must be based on a milk quality measured by the first indicator. See Examiner's Answer mailed September 11, 2009 ("Answer"), p. 8-9. That is, in order to make the claim indefinite, the Examiner continues to apply the "alternate construction" identified on page 10 of Applicants' Appeal Brief. In reply, Applicants respectfully reiterate the arguments from pages 9-11 of the Appeal Brief; the alternate construction would never be adopted by one skilled in the art, at least because it renders the claim internally contradictory, is inconsistent with the specification, and was never used or argued when applying prior art during prosecution. In short, the Examiner's alternate construction is implausible and, as such, cannot be a basis for rendering the claim indefinite. See Ex parte Miyazaki, 89 USPQ2d 1207, 1211 (Bd. Pat. App. & Inter. 2008).

Applicants reply further that other actions by the Examiner reflect that the rejection under § 112, second paragraph is unreasonable. First, in the paragraph bridging pages 11 and 12 of the Answer, the Examiner identifies and applies claim 1's primary, plausible construction - that the second indicator

measures a milk quality different from / not derived from the quality measured by the first indicator. Second, as pointed out on page 7 of the Appeal Brief, Applicants attempted to amend the claim to absolutely foreclose the Examiner's alternate construction in the March 5, 2009 after final response, but the Examiner indicated that even this amendment was indefinite in the March 20 Advisory Action. These actions reflect that the Examiner understands the definite primary construction of the claim phrase but is unwilling to accept any construction as definite. In light of this and the implausibility of the alternate construction, Applicants respectfully reply that the rejection under § 112, second paragraph is a result of the Examiner's idiosyncratic claim treatment and not in accordance with the law governing rejections for indefiniteness. Applicants respectfully maintain their request that the Board overturn the rejections under § 112, second paragraph to claims 1-3 and 5-7.

B. The Examiner's rejection for lack of enablement is based on an improper construction of the claim.

The Examiner replies in the Answer that, given the alternate construction discussed above and in the Appeal Brief, the claims are not enabled. Applicants reply only to recognize that the rejection under § 112, first paragraph turns entirely on that basis that, when the claim is implausibly interpreted as internally contradictory, it is not enabled. Applicants reiterate the argument advanced on pages 13-14 of the Appeal Brief that a person skilled in the art would never conclude that the alternate construction is within the scope of claim 1 and thus need not be enabled. See AK Steel Corp. v.

Sollac, 344 F.3d 1234, 1244 (Fed. Cir. 2003); MPEP § 2164.08(b). Thus, Applicants respectfully maintain their request that the Board overturn the rejections under § 112, first paragraph to claims 1-3 and 5-7 to the same degree that the rejections under § 112 second paragraph must be overturned.

C. The Examiner misapplies an automatic, dependent flow cutoff as an optional, independent mastitis indicator.

In response to the Applicants' argument that the limitation of claim 1, "a second indicator of mastitis" that is "not based on a milk quality measured by the first indicator" is missing from Van den Berg, the Examiner answers that the flow threshold "D" and its components "D1" and "D2" in van den Berg are such a second indicator of mastitis not based on a milk quality measured by the first indicator.

Applicants respectfully reply that the flow threshold in van den Berg is not an indicator of mastitis or a measurement of any other quality aspect of the milk. The flow threshold D, and its components D1 and D2, is a milk flow rate below which such flow is stopped. See van den Berg, Col. 2, ll. 14-22 (cited in Answer). Van den Berg nowhere determines if an udder has mastitis based on when milking ceased due to milk flow falling below D. Quite the opposite, the cutoff is explicitly determined based on the mastitis indicator in van den Berg's only conductivity test. See van den Berg, Col. 9, ll. 3-5 (cutoff based on mastitis indicator); Col. 8, ll. 25-28, 47-51 (only a conductivity test determines mastitis).

Even indulging the Examiner's argument that the threshold D is a mastitis indicator if someone reverse-engineered D to find mastitis indication (which van den Berg nowhere does), the **flow cutoff D is always determined/set**, and the **flow cutoff D is always set to a value derived from van den Berg's single mastitis indicator, "M."** This, in plural ways, still defies any interpretation of "**only if said first indicator of mastitis indicates mastitis**, a second indicator of mastitis is performed, said second indicator of mastitis **not based on a milk quality measured by the first indicator.**" Thus, where the Examiner argues in the Answer that the flow cutoff of van den Berg discloses the second logical indicator measuring a second distinct milk quality, the Examiner still has only highlighted the differences between the claims and the prior art under the § 103 Graham factor. Applicants respectfully maintain their request that the Board overturn the rejections under § 103(a) to claims 1-3 and 5-7.

IV. CONCLUSION

Appellants respectfully maintain their request that the Board reverse the Examiner's rejections of the pending claims 1-3 and 5-7.

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
HARNES, DICKEY, & PIERCE, P.L.C.

By:

John A. Castellano, Reg. No. 35,094
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

RA